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Appeal Brief
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of :
John C. Harvey and James W. Cuddihy : Group Art Unit: 2602
Serial No.: 08/113,329 : Examiner: J. Groody
Filed: August 30, 1993 : File No.: 5634/008
For **SIGNAL PROCESSING APPARATUS AND METHODS**

APPELLANTS' BRIEF (37 CFR § 1.192)

Box Appeals and Interferences
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I. REAL PARTY IN INTEREST (37 CFR § 1.192(c)(1))

Appellants, John C. Harvey and James W. Cuddihy, are the inventors of the claimed subject matter at issue on appeal. The real party in interest is the assignee of the application, Personalized Media Communications, L.L.C.

II. RELATED APPEALS AND INTERFERENCES (37 CFR § 1.192(c)(2))

There are no related appeals or interferences known to Appellants' legal representative which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Nevertheless, Appellants expect the issues raised by this appeal to be important in the ultimate disposition of other co-pending applications.

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III. STATUS OF CLAIMS (37 CFR § 1.192(c)(3))

The status of pending Claims 2, 3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, 49-84 are attached as Appendix A.

Appellants' appeal to the Board of Patent Appeals and Interferences from the Final Rejection of amended Claims 2, 3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, 49-84 in the Office Action, Paper No. 18, mailed May 23, 1996 (hereinafter "Office Action").

IV. STATUS OF AMENDMENTS (37 CFR § 1.192 (c)(4))

No substantive responses after Final Rejection were filed in this application.

V. SUMMARY OF THE INVENTION (37 CFR § 1.192(c)(5))

The invention relates to apparatus and methods for automatically controlling programming transmissions and presentations on television and radio equipment and monitoring the programming transmitted and presented. "Programming" in the context of this invention means any transmission of television or radio signals intended for communication of entertainment or to instruct or inform. The apparatus of the invention can receive and control programming transmitted either over-the-air or over hard-wire. The apparatus receives transmissions from as many as one hundred or more channels which are sequentially scanned by one or more scanners/switches. These scanners/switches (1) can transfer the transmissions to one or more receiver/decoders for identification of signals associated with the programming, and (2) can separate the signals from the programming transmissions. The signals may then be transferred through one or more decrypters. The separated and possibly wholly or partially decrypted signals are then transferred through one or more processors and buffers to external equipment and/or data recorders. The data recorders are adapted to output data to remote sites on

predetermined instructions. In all these functions, the apparatus is governed by one or more controllers. The methods coordinate and instruct equipment in the transmission and presentation of radio and television programming, especially in multi-media and multi-channel presentations.

VI. ISSUES (37 CFR § 1.192(c)(6))

The issues on appeal are based on the rejection of Claims 2, 3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, 49-84 based on the new non-statutory "non-obviousness double patenting" rejection as described in the Manual of Patent Examining Procedure (MPEP) § 804 (II)(B)(2) (6th ed. 1996). The issues are set forth as follows:

1. Whether the PTO's creation of a new non-statutory non-obviousness double patenting rejection constitutes substantive rulemaking that adversely affects the rights and interests of Appellants and is, therefore, outside the Commissioner's statutory grant of rulemaking power.

2. Whether the non-statutory non-obviousness double patenting rejection as set forth in the Office Action is contrary to established precedent and, moreover, unsupported by the precedent relied upon by the PTO.

3. Whether the new non-statutory non-obviousness double patenting rejection is expressly contrary to the provisions of 35 U.S.C. § 120.

4. Whether, assuming the existence of a non-statutory non-obviousness double patenting rule, the Examiner has properly applied the rule in this application.

VII. GROUPING OF CLAIMS (37 CFR § 1.193(c)(7))

All claims stand or fall together as they were rejected under the same rationale.

VIII. ARGUMENT (37 CFR § 1.192(c)(8))

THE OFFICE ACTION'S REJECTION UNDER THE NEW DOCTRINE OF NON-STATUTORY NON-OBVIOUSNESS DOUBLE PATENTING (37 CFR § 1.192(C)(8)(V)) IS ERROR OF LAW AND IMPROPER.

Appellants' respectfully seek reversal of the Examiner's double patenting rejection on four separate grounds, any one of which warrants the Board's reversal. First, the applied section, MPEP § 804 (II)(B)(2) (6th ed. 1996), creating and defining non-statutory non-obviousness double patenting, is a substantive new rule affecting the rights and interests of Appellants. Therefore, the promulgation of this rule is outside the Commissioner's grant of statutory power and without the force of law. Second, the PTO's new rule as set forth in MPEP § 804 and the Examiner's rejection are premised on an improper interpretation of In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968), and therefore constitute an error of law. Third, the new rule is directly contrary to the express requirements of 35 U.S.C. § 120. Fourth, regardless of the propriety of the new non-statutory non-obviousness double patenting rule defined in MPEP § 804 (II)(B)(2)(6th ed. 1996), and as amplified in the Office Action, the Examiner has failed to establish that this new type of rejection applies to the factual situation of the present application. Each contention and error of law is addressed below.

**A. THE PTO'S NEW NON-STATUTORY NON-OBVIOUSNESS
DOUBLE PATENTING REJECTION IS AN UNLAWFULLY
PROMULGATED SUBSTANTIVE RULE OUTSIDE THE
COMMISSIONER'S STATUTORY GRANT OF POWER.**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6(a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed Cir. 1991).¹ In considering this appeal, the Board owes no "interpretive" deference to the Commissioner. Appellants respectfully submit that the Commissioner's creation of a new non-statutory non-obviousness type of double patenting in MPEP § 804 (II)(B)(2)(6th ed. 1996) based upon In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968), constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

**1. Non-Statutory Non-Obviousness Double Patenting Is Not Valid
Because The PTO Commissioner Has Unlawfully Promulgated A New
Substantive Rule.**

The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of

¹ Accord Hoechst Aktiengesellschaft v. Quigg, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed Cir. 1990); Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990); Ethicon Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir 1988).

power. Chevron v. Natural Resources Defense Council, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. Merck & Co., Inc. v. Kessler, 80 F.3d 1543 (Fed. Cir. 1996), citing, Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991). Therefore, as an initial matter in this appeal, the Board must decide whether new MPEP § 804 (II)(B)(2)(6th ed. 1996), created and first promulgated in 1996 to set forth a new basis for rejection -- "non-statutory non-obviousness double patenting" -- is a substantive or procedural rule.

The appropriate test for such a determination is an assessment of the rule's impact on the Appellants' rights and interests under the patent laws. Fressola v. Manbeck, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to double patenting. Merck & Co., Inc. v. Kessler, 80 F.3d 1543 (Fed Cir. 1996), citing, Chevron v. Natural Resources Defense Council, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. Nat'l Ass'n of Home Health Agencies v. Scheiker, 690 F.2d 932, 949 (D.C. Cir. 1982), cert. denied, 459 U.S. 1205 (1983).

2. The New Double Patenting Rule Is Substantive Because It Radically Changes Long Existing Patent Practice by Creating a New Double Patenting Standard and a New Type of Double Patenting Rejection.

The new third type of double patenting recently set forth in MPEP § 804 is totally distinguishable from the two well established types of double patenting because (1) it creates and imposes a new substantive test for double patenting and (2) it results in a separate and distinct rejection of pending claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).² These two well established types of double patenting use an objective standard to determine when they are appropriate³ and have a determinable result on the allowability of the pending claims.

The new subjective test for double patenting represents a radical departure both in the test and the effect. The two well established double patenting standards are based on an objective analysis of comparing pending and allowed claims. The new double patenting rule uses a radically different test. This radical new test is defined, in part, as: "Is there any reason why applicant was prevented from

²MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquires set forth in Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

³ The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

presenting the same claims for examination in the issued patent"? MPEP § 804(II)(B)(2)(6th ed. 1996). This radical new "any reason why" test has all the hallmarks of a subjective standard, e.g. it is facially ambiguous and provides no objective rationale or predictability regarding precisely what circumstances can be reasonably expected to clear the "any reason why" hurdle.

The new "any reason why" standard is clearly a new subjective standard as demonstrated by its inconsistent application in this very case⁴. For example, both a restriction requirement and a multiplicity rejection were imposed in the parent cases on which the present application is based. The Examiner ultimately conceded that the restriction requirement and the multiplicity rejection prevented the Appellants from pursuing the present claims in a parent application. The Examiner accepted the restriction requirement as sufficient under the "any reason why" standard and withdrew the new non-statutory non-obviousness rejection based on parent cases with a restriction requirement. Addressing the multiplicity rejection, however, the Examiner determined that the multiplicity rejection did not satisfy the "any reason why" standard.⁵ Appellants respectfully submit the multiplicity bar to presenting claims literally satisfies the "any reason why" standard and is as deserving as a restriction requirement in this respect. As the two well established double patenting types both use very different standards and rationale for rejection,

⁴It is important to note that an applicant merely availing him or herself to the rights and benefits conferred by the patent statutes is per se NOT sufficient to satisfy the new "any reason why" standard.

⁵ By not accepting a multiplicity rejection as sufficient under the "any reason why" standard, the Examiner places Applicants in an untenable catch-22 situation. Specifically, claims may be initially barred under the multiplicity rejection and then subsequently require a terminal disclaimer under the "any reason why" standard, thereby depriving Applicants of the full statutory patent term.

the new subjective standard of MPEP § 804 constitutes a substantive change to existing patent practice.

The new non-statutory non-obviousness double patenting standard also is a substantial change to existing practice because its application produces a different outcome from the two recognized types of double patenting. Statutory double patenting requires Applicants to claim a different invention with each application (having the practical result of not allowing the rejected claim). Obviousness-type double patenting requires the terminal disclaimer of the pending application to the expiration date of the claims of an issued patent (having the practical result of requiring a terminal disclaimer based on a claim by claim analysis). The new standard requires a terminal disclaimer based on the "disclosure of" the earliest issued patent (having the practical result of requiring a terminal disclaimer over the earliest issued patent).

In summary, the new MPEP § 804 (B)(II)(2)(6th ed. 1996) standard departs from long- established practice because it (1) creates a new third type of double patenting, (2) imposes a new subjective double patenting standard, and (3) produces different results. Therefore, the new non-statutory non-obviousness double patenting rule is a substantive rule beyond the rulemaking authority of the PTO and therefore, invalid.

3. The New Non-Statutory Non-Obviousness Double Patenting Rule Is Also A Substantive Rule Because It Adversely Impacts The Rights And Interests Of Appellants To Benefits of the Patent.

The rights and benefits of a U.S. patent is solely a statutory right. Merck & Co., Inc. v. Kessler, 80 F.3d 1543 (Fed Cir. 1996). The essential statutory right in a

patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. Freesola v. Manbeck, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, In re Pilkington, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and In re Steppan, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

The new non-statutory non-obviousness double patenting rule, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Appellants' ability to claim their invention and, therefore, must be considered a substantive rule. The new non-statutory non-obvious double patenting rule with its new "any reason why" standard denies Appellants of rights and benefits expressly conferred by the patent statute. One measure of the value of these denied rights and benefits is that the new non-statutory non-obvious double patenting rule, as applied here, would require Appellants to disclaim *almost ten years of the term* of the presently allowed application.⁶ Appellants respectfully submit that the disclaimer of over one half of the 17 year term of a patent, to which they are fully entitled by statute⁷, has a huge impact on their rights and interests in the presently claimed invention.

In summary, the Board should find the new non-statutory non-obviousness double patenting rule is a change to long existing practice and/or has a substantive

⁶ The claims on appeal are allowed "but for" the new non-statutory non-obviousness rejection.

⁷ See Sections (C)(2) through (4) below.

impact on the rights and interests of Appellants to their invention. Either finding means that the new non-statutory non-obviousness double patenting rule is a substantive rule. Since the Commissioner has no power to issue substantive rules, MPEP § 804 (II)(B)(2) (6th ed. 1996) is an improperly promulgated substantive rule having no force of law that cannot form the basis for a proper rejection. The Board should reverse this error of law and allow the claims.

B. THE PTO HAS INCORRECTLY INTERPRETED THE IN RE SCHNELLER DECISION. THE NEW NON-STATUTORY NON-OBVIOUSNESS DOUBLE PATENTING REJECTION IS ERROR OF LAW.

Based on the above, Appellants believe that the new non-statutory non-obviousness double patenting rule is substantive. Of course, the PTO may promulgate merely procedural non-substantive rules.⁸ The Board owes no deference to the Commissioner in evaluating the new non-statutory non-obviousness double patenting rule and should review the Commissioner's ruling *de novo* as a matter of law. First, Applicants respectfully submit the Commissioner has incorrectly interpreted the Schneller decision and, therefore, the new double patenting rejection is based on error of law. Second, the Commissioner's reasoning is contrary to the express mandate of the patent statute.

The Office Action rejects the claims of the present application under a non-statutory non-obviousness double patenting rationale based on Appellants' existing patented inventions covered by four of its issued patents. The Examiner bases this rejection on MPEP § 804 (II)(B)(2)(6th ed. 1996). The sixth edition, initially published in 1996, is the first MPEP to instruct Examiners on this "new" alleged type of double patenting, and permit rejections based on it. As the sole support for this new type of double patenting, the MPEP relies on Schneller, a 1968 Court of Customs and Patent Appeals decision. See, MPEP § 804 (II)(B)(2) (6th ed. 1996)(citing, In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968)).

⁸ The APA provides § 553(b) does not apply, i.e. substantive rulemaking requirements, to "interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice . . ." 5 U.S.C. § 553(b)(A).

The PTO's reading of Schneller as standing for the existence of so-called "non-statutory non-obviousness double patenting" represents an untenable interpretation of existing case law. First, Appellants will demonstrate that the PTO relies upon ambiguous statements in Schneller from which to fashion a new third doctrine in the law of double patenting. Second, Appellants will show that in the 28 years since the Schneller decision, no court, learned scholar, or prior PTO supervisory personnel have found the decision to stand for the existence of a third type of double patenting. Third, Appellants will demonstrate that Schneller was decided under the law of classic obviousness-type double patenting as recognized in leading cases such as In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970). Accordingly, Schneller does not create a new third doctrine of double patenting.⁹

1. The PTO's Decision To Reject The Application Improperly Relies On Ambiguous Statements In Schneller, Not Its Holding.

In section 804 (II)(B)(2) of the 6th edition of the MPEP, the PTO creates the new non-statutory non-obviousness double patenting rejection. The MPEP states the following:

There are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are considered non-obvious over each other. These circumstances are illustrated by the facts before the court in In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (CCPA 1968).

⁹ Appellants will also demonstrate in Section C below that MPEP § 804 (II)(B)(2) (6th ed. 1996) is merely an attempt to revive the long discredited doctrine of "late claiming" under the rubric of the new "non-statutory non-obviousness" double patenting.

MPEP § 804 (II)(B)(2) (6th ed. 1996). Schneller is the sole judicial underpinning cited as the basis for this conclusion. The MPEP further states:

In making an analysis for this type of non-statutory double patenting, the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, the second question is: Is there any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, a double patenting rejection is appropriate.

MPEP § 804 (II)(B)(2) (6th ed. 1996).

MPEP § 804 (II)(B)(2)(6th ed. 1996) proposes a three prong test: (1) whether the claims are supported by the specification; (2) whether the pending claims are “covered” by an issued claim; and (3) whether there was “any reason why applicant was prevented from presenting the same claims for examination in the issued patent.” For reasons explained above, this rationale for rejection is improper. In addition to the inquiries set forth in MPEP § 804 (II)(B)(2), the Examiner asks the further question of (4) whether the inventions in the present application and the issued patents are independent and distinct. This fourth inquiry is not explicitly set forth in MPEP § 804 (II)(B)(2). However, the Examiner appears to believe that it is implicit therein.¹⁰

¹⁰To support his rejection based on the “independent and distinct” rationale the Examiner cites and relies in the Office Action on ambiguous statements of Schneller to justify his double patenting rejection. The Examiner ignores the Schneller case’s holding in an attempt to justify his double patenting rejection. The Office Action states that “[the] CCPA in Schneller used the independent and distinct standard as the main factor in its determination that the double patenting rejection should be affirmed.” Office Action, at page 4. Clearly, Schneller states that the invention claimed in the patent must be independent and distinct from the claims in the application. In re Schneller, 397 F.2d at 353-54. This statement, however, does not support the creation of a new type of double patenting. The Schneller court found that the claims in the patent “are ‘comprising-type’ claims, [and, therefore] they ‘cover’ both versions of the clip disclosed both in the patent and in the present application because they read squarely thereon.” In re Schneller, 397 F.2d at 354. These statements are clearly the first steps in support of a traditional obviousness double patenting analysis.

Neither the standard set forth in MPEP section 804 (II)(B)(2) nor the standard as amplified by the Examiner in the Office Action is proper, as will be explained in detail below.

In creating a third type of double patenting from the Schneller decision, the PTO and the Examiner of this application rely on the CCPA's statement that the Schneller facts did not present "the usual 'obviousness-type' double patenting case." In re Schneller, 397 F.2d at 353-54. In making this statement, the Schneller court sought to distinguish the usual double patenting circumstance from the Schneller facts. The usual double patenting circumstance involves the addition or subtraction of an element from a patent's claims. However, "nonobviousness" as a standard for patentability as set forth in 35 U.S.C. § 103 is not limited to just these two circumstances. The substitution of one element for another, as in Schneller, can be a third type of "obvious" step precluding the allowance of a patent. Thus, when comparing pending and allowed claims under the "obviousness-type double patenting" standard, any of these circumstances (addition or subtraction of an element or substitution of one element for another) could support an obviousness-type double patenting rejection. This is precisely what the CCPA was referring to when it found in Schneller that an obvious substitution of elements supported a rejection based on double patenting. Accordingly, Schneller does not create a third type of double patenting. The case, in actuality, is decided under the traditional two-type double patenting regime. Schneller is simply an obviousness-type double patenting case.¹¹

¹¹ See footnote 12, *infra*, demonstrating that Schneller has always been cited in this manner.

The impropriety of the PTO's current reading of Schneller is further amplified in the next two subsections, where Appellants demonstrate that other scholars fail to find a basis for the PTO's expansive reading (as did the PTO itself for the 28 years following Schneller) and that the Schneller holding is clearly consistent with and supports the traditional two types of double patenting taught by leading cases like In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970).

2. The PTO Remains Alone In Finding The Existence Of A Non-Statutory Non-Obvious Double Patenting Standard For Rejection.

Appellants submit that the case law supports only two types of double patenting. Thus, the non-statutory non-obvious third type, which the PTO applies, results from an improper reading of case law. The two types of double patenting supported by all case law, learned scholars, and respected authorities are: (1) same invention, or statutory, double patenting under 35 U.S.C. § 101, and (2) an obvious modification of the same invention, termed "non-statutory obvious-type double patenting". This subsection demonstrates that the PTO remains alone in incorrectly finding that there exists an additional form of double patenting -- non-statutory non-obvious double patenting.

To Appellants' knowledge, Schneller has been cited a total of six times in reported decisions in the 28 years since its issuance. No court has held that Schneller stands for the existence of a non-statutory non-obvious double patenting category. The cases that cite Schneller make no reference or inference to non-statutory non-obvious double patenting; in fact, they simply cite the case for its articulation of the standards and reasoning underlying the two existing categories of

double patenting discussed above.¹² Moreover, neither the Court of Customs and Patent Appeals, nor its successor court, the Federal Circuit, have recognized the existence of a non-statutory non-obvious double patenting preclusion in cases not citing Schneller.

This absence of an acknowledgment of the existence of the so-called "third type" in subsequent double patenting cases is a strong indication that the Schneller holding is strictly confined to its factual situation and that its ambiguous language has no precedential value. In fact, the Federal Circuit's behavior in the 28 years following the Schneller decision completely supports the Appellants' view that the PTO's application of a non-statutory non-obvious double patenting represents an untenable reading of case law, and is, therefore, an *ultra vires* action by the PTO.

An examination of legal scholarship further supports the results found during the examination of case law: the PTO remains alone in incorrectly finding that there exists this additional non-statutory non-obvious form of double patenting, and that Schneller stands for such a proposition. With respect to learned patent law scholars, Appellants could provide a string of citations to support their contention that there exists only two types of double patenting. The point, however, is sufficiently demonstrated with examples from three of the most respected

¹² The cases citing Schneller are: In re Goodman, 11 F.3d 1046, 1049 (Fed. Cir. 1993)(citing Schneller for the fundamental rationale underpinning double patenting); In re Braat, 937 F.2d 589, 595 (Fed. Cir. 1991)(citing Schneller for the fundamental rationale underpinning double patenting); Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 359 (Fed. Cir. 1986)(citing Schneller in a parenthetical citation to In re Zickendraht); In re Van Ornum, 686 F.2d 937, 943 (C.C.P.A. 1982)(citing Schneller to acknowledge the fundamental rationale underpinning double patenting); Union Carbide Corp. v. Dow Chemical Co., 619 F. Supp. 1036, 1056 (D. Del. 1985)(quoting Schneller for the proposition that a patent resulting from a requirement to restrict is immune from a double patenting rejection); Kaz Manufacturing Co., Inc. v. Northern Electric Co., 412 F. Supp. 470, 486 (S.D.N.Y. 1976)(citing Schneller for the proposition that only the claims should be looked at for a double patenting rejection, and that invention claimed must be independent and distinct).

scholars in the field: Donald S. Chisum, Robert L. Harmon, and Peter D. Rosenberg. Each author examines the patent examination process from a different perspective: professor, practitioner, and examiner, respectively.

Professor Chisum in his patent treatise states “[in] a line of cases beginning in 1964, the Court of Customs and Patent Appeals developed a distinction between two types of double patenting.” 3 Donald S. Chisum, Patents § 9.03[3][a] (Rel. 5.5 1995). Professor Chisum, describes the two types of double patenting with a discussion of the 1970 Vogel decision. Id. (citing In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970)). Patent practitioner Harmon in his text describes only two types of double patenting when he states “[the] doctrine that forbids so-called double patenting precludes one person from obtaining more than one valid patent for either (1) the same invention, or (2) an obvious modification of the same invention.” Robert L. Harmon, Patents and the Federal Circuit, § 15.5 (3d ed. 1994). Examiner Rosenberg in his patent law treatise states “there are two types of double patenting: (1) the ‘same invention’ type . . . and (2) the ‘obviousness’ type” 2 Peter D. Rosenberg, Patent Law Fundamentals, § 15.05 (2d ed., Rel. 35 1995). Clearly, there exists a broad consensus among learned scholars in all cross-sections of patent law that the law of double patenting contains two and only two types of double patenting.

Further, Appellants’ literature search finds no discussion addressing the third type of double patenting. Appellants have searched each issue of the Journal of the Patent [& Trademark] Office Society, arguably the most complete and respected periodical addressing patent law issues, from the date of the Schneller decision in

1968 to the present. Appellants report that their efforts have uncovered not a single article addressing the topic or case. In Appellants' view, if Schneller represents the monumental change in jurisprudence that the PTO asserts, the case would have been the subject of at least one article, comment or note, letter to the editor, or footnote – yet none occurred. Appellants assert it is crystal clear that at the time of the Schneller decision, the parties involved in the case, contemporaries in the field, the deciding court's clerks, students, examiners, academics, and practitioners, did not view the case as a paradigm shift, but rather another routine case addressing obviousness-type double patenting, not worthy of specific attention.

Finally, for 28 years following the Schneller decision, the PTO itself did not view the case as a major shift in principle. The previous editions of the MPEP explicitly describe the double patenting on the same basis as that Appellants urge in this brief: "There are two types of double patenting rejections. One is the 'same invention' type double patenting rejection . . . [t]he other type is the 'obviousness' type double patenting rejection" MPEP § 804 (II)(B)(2) (5th ed., rev. 16 1994). The discussion of Schneller in the sixth edition of the MPEP is the first appearance of this case in the MPEP. Two entire editions, and numerous revisions within each edition of the MPEP have been issued since 1968 without a mention of Schneller or the concept of non-statutory non-obvious double patenting. Appellants contend that the current PTO revisionism based on Schneller results from a misguided reliance on ambiguous statements, as discussed *supra*. Further, as demonstrated *infra*, the Schneller holding is a classic obviousness-type double patenting decision.

3. **Schneller does not support the creation of a third type of double patenting.**

The PTO's reliance on Schneller to establish a third-type of double patenting is totally misplaced. When properly read, Schneller fits into the well established double patenting regime disclosed in leading cases such as Vogel. For completeness, Appellants will first review double patenting as it currently exists. Next, Appellants will demonstrate that Schneller is a case decided under non-statutory obviousness type double patenting.

The Existence of only Two Types Of Double Patenting Is Well Established In Sound Case Law.

The first type of double patenting, "same invention double patenting", finds its support in the language of 35 U.S.C. § 101 which states that an inventor who comes up with any new and useful process "may obtain a patent therefore" In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1988). The test for same invention double patenting is based on asking the question: "Is the same invention being claimed twice?" In re Vogel, 422 F.2d 438, 441 (C.C.P.A. 1970). To answer this question it is helpful to determine "whether one of the claims [being compared] could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." Id.

The second type of double patenting is a "judicially created doctrine intended to prevent improper timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not 'patentably distinct' from claims of a first patent." In re Braat, 937 F.2d 589, 592 (Fed. Cir. 1991)(citing In re Longi, 759 F.2d at 887). The doctrine prohibits "claims in the second patent which define merely an obvious variation of an invention claimed in first patent." Id. This type of double patenting rejection is analogous in operation to 35 U.S.C. § 103 "except that

the patent principally underlying the double patenting rejection is not considered prior art.” In re Longi, 759 F.2d at 892, n.4 (citing In re Braithwaite, 379 F.2d 594, 600 n.4, 54 C.C.P.A. 1589, 154 U.S.P.Q. 29 (C.C.P.A. 1967)). Obviousness type double patenting is a question of law. In re Goodman, 11 F.3d 1046, 1051, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993); Texas Instruments Inc. v. International Trade Commission, 988 F.2d 1165, 1179, 26 U.S.P.Q.2d 1018, 1029 (Fed. Cir. 1993).

The test for obviousness type double patenting is based on asking the question: “Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?” In re Vogel, 422 F.2d at 441. The question is answered by determining if the claim in the later filed application would be obvious in view of the claims in the patent. In re Longi, 759 F.2d at 893 (citing Carman Industries Inc. v. Wahl, 724 F.2d 932, 940, 220 U.S.P.Q. 481, 487, n.5 (Fed. Cir. 1993)). In making the determination, one may not use the patent disclosure itself as prior art. Id.; In re Aldrich, 398 F.2d 855, 158 U.S.P.Q. 311 (C.C.P.A. 1968); In re Boylan, 392 F.2d 1017, 157 U.S.P.Q. 370 (C.C.P.A. 1968). Objective indications may be used as with a 35 U.S.C. § 103 rejection analysis.

4. Schneller Was Decided Under Non-Statutory Obviousness Double Patenting And Thus Does Not Create An Extraneous Third Category.

Schneller’s holding is clearly a part of the existing two type double patenting regime. The court in Vogel established the two part test, discussed *supra*, for analyzing double patenting. The first inquiry relates to statutory double patenting and asks whether the same invention is being claimed twice. The test is whether one of the claims of the application can be literally infringed without infringing one of the claims of the existing patent, and vice versa. If the answer is no, then double patenting does not exist.

The existing patent in Schneller claimed a clip comprising the elements A, B, C, and X. The application claimed a clip with elements A, B, C, X, and Y. Applying the test for statutory double patenting to the facts in Schneller, the A, B, C, X, and Y claim would literally infringe the claim of the patent because of the open language in the patent claim. The claim in the patent, however, would not literally infringe the claim in the application. Thus, there is no statutory double patenting.

The obviousness-type double patenting asks whether any claims in the application merely define an obvious variation of an invention disclosed and claimed in the patent. Here, objective indications can be used to prove obviousness. The Schneller invention related to a wire clip for attaching lath sheets to a structural framing member. Elements A, B, and C, known in the prior art, were an elongated body, a loop portion, and a prong respectively. Schneller, 397 F.2d at 354. Element X was a leg offset from the prong, and element Y was a lip to secure the edge of the next sheet of lath. Id. The Schneller patent disclosed elements A, B, C, X, and Y as the best mode and claimed elements A, B, C, and X. Id. The application claiming elements A, B, C, and Y and elements A, B, C, X, and Y would be obvious to one skilled in the art. Making the new combination would merely exercise skill or ingenuity expected of a person with ordinary skill in this art because X and Y were known to the art. The patent application of Schneller was rejected under the obviousness-type double patenting test as defined in Vogel, which is the currently used test.

In finding a third type of double patenting in the Schneller factual situation, the PTO relies on the court's observation that the facts did not present "the usual

'obviousness-type' double patenting case." In re Schneller, 397 F.2d at 353-54. This statement, however, merely represents the deciding court's commentary regarding the uniqueness of the factual circumstances surrounding the element composition of the application. It most certainly does not reflect the creation or recognition of an entirely new category of double patenting rejection. Specifically, the court's statement means that the unusual nature of the case was that of the substitution of element X for element Y, not the addition or subtraction of an element from the patent's claims. As explained above in Section C.1, the substitution of elements is a common basis for an obviousness rejection. The use of such an analysis does take Schneller outside the typical double patenting analysis. Schneller does not create a third type of double patenting. The case itself was actually a case decided under the two-type double patenting regime.

Thus, the Schneller decision provides no basis for the Commissioner's establishing a third type of double-patenting. His promulgation of the new provision in MPEP § 804 is improper and contrary to law. The rejection should be reversed on this basis alone.

C. THE REJECTION IS DIRECTLY CONTRARY TO THE REQUIREMENTS OF 35 U.S.C. § 120 AND AN ATTEMPT TO REVIVE THE LONG DISCREDITED DOCTRINE OF "LATE CLAIMING".

In the Office Action, Schneller is cited to support the proposition that Appellants are barred from presenting claims in a continuing patent application if there exists "any reason why" the claims could not have been presented earlier. Appellants submit that the Office Action is an attempt to use the "new" non-statutory non-obviousness double patenting rule to revive the long discredited doctrine of late claiming. This conclusion is most evident from the manner in which the new double patenting standard is applied, i.e. it serves as an arbitrary bar to prevent claims in a continuing application from issuing based on the examiner's subjective assessment of what constitutes a "timely" application. The Court of Customs and Patent Appeals has addressed this point in the years following Schneller.

1. "Late Claiming" Is A Long Discredited Doctrine.

The discredited doctrine of "late claiming" was once improperly employed to bar protection to a patent applicant who failed to "timely" claim the subject matter disclosed in the specification of his or her initial application. See, e.g., Westphal v. Fawzi, 666 F.2d 575 (C.C.P.A. 1981). Under 35 U.S.C. § 120, a patent applicant may submit additional claims in a subsequent application which are supported by the disclosure in the original application's specification. A proper continuation application and its original application, known as the "parent" of the continuation application, are considered "parts of the same transaction, and both as constituting one continuous application, within the meaning of the law." In re Hogan, 449 F.2d

595, 603 (C.C.P.A. 1977)(quoting Godfrey v. Eames, 68 U.S. 317, 325-6 (1864); Square Liner 360 Degrees, Inc. v. Chisum, 691 F.2d 362 (8th Cir. 1982)(same). Thus, the continuation application is afforded the benefit of the priority of the filing date of the parent application as to all prior art. *Numerous controlling court decisions have squarely held that a claim may be written and presented at any point in a sequence of patent applications, so long as it is supported by the original specification of the parent application.* The Westphal case is illustrative. In a dispute between two inventors as to the priority of the invention, the Westphal court determined that an application raising new claims for compounds useful as herbicides, seeking the benefit of a parent application's filing date of eight years earlier, had priority over claims filed by the competing inventor, whose patent application was submitted after the date of the other inventor's parent application. Westphal, 666 F.2d at 576. This was so despite the competing inventor's contention that the claims had been submitted "late," and therefore, should not have been issued as a patent. Id. at 576-77.

The CCPA held that the subsequent applicant's contention of late claiming did not affect the right to claim the benefit of the earlier filing date. Id. at 577. That he "couch[ed] his argument in non-statutory 'late claiming' terms," like the Office Action here, was "of no moment." Id. The court articulated the now settled rule of law: "later submitted claims need only be reviewed for support in the original disclosure under § 112, first paragraph."¹³ Therefore, "[if] Westphal had presented a

¹³ Section 112, first paragraph is expressly incorporated into 35 U.S.C. § 120, which is the continuation procedure under the patent laws. Section 112, first paragraph provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Thus, the claims of the subsequent continuation application under Section 120 must be supported, as described above, in the parent application's specification.

'late claiming' argument properly understood, it would have raised only the question of whether [Fawzi] had adequate support in his [original] disclosure, as of its filing date, for the later-submitted . . . claims." *Id.* Because there was adequate support under Section 112 in the parent application, the priority was upheld and the "late claiming" doctrine was rejected, as it was "not a viable doctrine." *Id.* at 578.

The Federal Circuit adopted the CCPA's view of late claiming quite early in its jurisprudence in Correge v. Murphy, 705 F.2d 1326 (Fed. Cir. 1983), observing that Westphal had rejected the doctrine and noting that "[in] light of the sufficiency of the disclosure [a party] can not raise any so-called 'late claiming' issue." *Id.* at 1329 n. 4. Thereafter, the Federal Circuit has consistently maintained this position. In an opinion one year later in Railroad Dynamics Inc. v. A. Stucki Co., 727 F.2d 1506 (Fed. Cir. 1984), the Federal Circuit reinforced its rejection of the late claiming doctrine, and observed that it can come dressed in a variety of disguises:

RDI included among its plethora of defenses one to which it applied at trial the **inappropriate and long ago discredited "late claiming" label**. Because Stucki had amended its claims in the course of prosecuting its application, RDI created from that single fact, four variously labeled "defenses" As the District Court correctly recognized, **the sole question raised . . . is whether the claims entered by amendment were supported by the disclosure in Stucki's original application. . . .** RDI's argument that the patent should be held invalid in light of this many-labeled defense is and always was without merit.

Railroad Dynamics Inc., 727 F.2d at 1517. (emphasis added).

Still later, the Federal Circuit upheld a district court decision rejecting a claim of unnecessary delay in obtaining a patent in Studiengesellschaft Kohle v. Northern Petrochemical Co., 784 F.2d 351 (Fed. Cir. 1986). The patent in Studiengesellschaft Kohle involved a process for making polypropylene, the parent application of which was filed in 1955. *Id.* at 352. Because of three patent interferences involving the application, prosecution of the application was stayed in the PTO for 16 years,

from 1961 until 1977. Id. at 353. Notwithstanding this, however, the district court held that Studiengesellschaft Kohle had not violated or exceeded the time period limits provided by the patent statute. Id. at 356. The Federal Circuit, therefore, affirmed the lower court's decision. Id.

A recent decision of this Board, Ex parte Hyatt, No. 91-0984 (March 16, 1992)(Ex. 1), has also followed the Federal Circuit's lead. Notwithstanding a delay of nine years between the filing of the continuation application and the original filing, the Board held that "the Appellant has done what is provided for in the statute and relevant rules and practice of the [PTO] in filing the present continuing application. **35 U.S.C. Section 120 does not place a time limit on filing the continuing application.** Rather, all that is required to preserve an earlier effective filing date as to common subject matter is copendency or a continuous chain of copendency." Id. at 8. (emphasis added). Accordingly, the Board reversed the rejection of claims on the basis of purported pre-issuance laches. Id. at 9.

The case law makes clear that the only relevant inquiry concerning claims filed in a subsequent continuation application pursuant to Section 120 is whether they are adequately supported in under Section 112, first paragraph, in the initial application. If the support exists, the inquiry is at an end. The Office Action's statement that "there is no apparent reason why applicants were prevented from presenting claims corresponding to those of the instant application during prosecution of the parent applications which matured into patents", Office Action at

page 3, presents no valid justification for a non-statutory non-obviousness double patenting rejection.

Nothing in Section 120 requires that an applicant assert in the originally-filed application claims to every invention disclosed therein. Indeed, such a requirement would be contrary to the very purpose and function of Section 120. So long as the continuation application is "filed before the patenting or abandonment of or termination of proceedings" on the parent application, Section 120 does not require that claims to an invention be filed within any particular time limit.

Furthermore, although other sections of the Patent Act contain time limits, there are no time limits specified in Sections 120 or 121. The wide latitude given to applicants for filing continuation or divisional applications is not accidental. Where there is a danger of abusive delay, the Patent Act specifically sets time limits which must be strictly obeyed.¹⁴

Also, the language of Sections 120 and 112, first paragraph are unambiguous. "Unless exceptional circumstances dictate otherwise, '[when a court] find[s] the terms of a statute unambiguous, the judicial inquiry is complete.'" Burlington Northern Railway Co. v. Oklahoma Tax Comm'n, 481 U.S. 454, 461 (1987). Indeed, "[acceptance] of [defendants'] position would require recognition of a nonstatutory

¹⁴ Other time limits in the Patent Act provide important contrasts to the absence of any time limit in Section 120. Section 133, for example, requires applicants to respond to Office Actions by the PTO within six months or the application is deemed abandoned. Section 135 limits to one year the time period in which an applicant may copy claims from an issued patent in order to provoke an interference action: a proceeding in the PTO to have patented claims transferred to the applicant instead of the patentee. Additionally, Sections 251 and 252 codify a two-year limit during which the patentee may apply for a broadening "reissue" of originally issued patent claims, which may afford an infringer of the broader, reissued claims a possible "intervening rights" protection, a laches-type defense. Accordingly, Congress knows how to impose time limits in the provisions of the Patent Act when it chooses to do so. The conspicuous absence of any such time limits in Section 120, therefore, cannot be deemed an oversight. See Section (C)(4) below.

exception to the clear language of section 120." In re Bauman, 683 F.2d 405, 407 (C.C.P.A. 1982). This is not permissible.

Infringers or competing inventors have, at various times, proposed grafting time restrictions onto Section 120 based on the number of continuations, the term of any patent issuing from a continuation, or the overall length of pendency of the series of applications. In each and every instance the courts have rejected such intentions.

2. There Is No Limit On The Length Of Pendency Of A Chain Of Continuation Applications.

In In re Hogan, 559 F.2d 595 (C.C.P.A. 1977), the CCPA was faced with a chain of continuation applications extending over twenty-four years, and a contention that invalidating prior art should overcome the claim of priority for that chain of applications despite compliance with Section 120. Id. at 597. The CCPA held that despite this, the only question at issue was whether the initial application provided adequate support for the subsequent continuation applications under Section 112, first paragraph. Id. at 603-04.

The very purpose of the reliance on Section 120, the court observed, was to "reach back" to the original filing date to "avoid the effect of intervening [prior art] references." Id. at 604. To do otherwise would "render the 'benefit' of 35 U.S.C. § 120 illusory." Id. In fact, to judge such a continuation application in "isolation," without a relation back to the original filing "would have a chilling effect upon the right of the applicants to file continuations." Id. at n.13. Thus, although the Court noted that "the 24 years of pendency herein may be decried, . . . a limit upon

continuation applications is a matter of policy for Congress, not for us.” Id. “As presently constituted, the law set forth in 35 U.S.C. §§ 112 and 120 is the same for all applications, whether of long or short pendency.” Id. “The clear and unambiguous language of § 120 states” that an adequately supported continuation application “shall have the same effect, as to such invention, as though filed on the date of the prior application” Id. at 604. The later application [1971], therefore, “should have been tested for compliance with § 112, first paragraph, ‘as though filed on the date of the prior application [1953].’” Id. at 604.

3. There Is No Limit On The Number Of Continuation Applications An Applicant May File.

Similarly, in In re Henricksen, 399 F.2d 253 (C.C.P.A. 1968), the CCPA was faced with a series of six continuation applications pending for over 18 years. Significantly, unlike Harvey’s continuation applications – each of which resulted in an issued patent – all four of the intermediate continuation applications of Henricksen, were ultimately abandoned. Id. at 255. Notwithstanding this, the CCPA stated that “[the] sole issue presented by this appeal is the interpretation of 35 U.S.C. § 120.” Id. at 253-54. After a detailed review of the legislative history of Section 120, the court expressly held that “there is no statutory basis for fixing an arbitrary limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of copending applications, provided [the] applicant meets all the other conditions of the statute.” Id. at 254.

Thus, the basic requirements of Section 120 have been summarized as (1) copendency (i.e. the later filed application must be filed before “the prior application” is patented, abandoned or the proceedings are terminated); (2) continuity of disclosure (i.e. it relies upon and is supported by the parent application’s specification); (3) coinventorship (i.e. the subsequent application lists the same inventor(s) as the parent); and (4) specific reference to the earlier application (i.e. the continuation application references the parent). See In re Bauman, 683 F.2d 405, 407 (C.C.P.A. 1982).

4. The Legislative History Of Section 120 Makes Clear That The Absence Of Limitations Was Purposeful.

The legislative history of Section 120 of the Patent Act also supports the notion that the absence of time limits in that provision is not an oversight. A preliminary draft of Section 120 had proposed that “[the] term of the patent granted on said later application shall not extend beyond the date of expiration of the patent, if any, which may be granted on the earlier application.” Congress, however, specifically deleted that provision from Section 120 before its enactment. See In re Bauman, 683 F.2d at 410 n.12. In Bauman, the CCPA held that “the deletion of this provision” in the final version of Section 120 “indicates that Congress did not intend limitations such as patent expiration date with that of the patent issued on the parent application to be imposed on the patent issuing on the continuation application.” Id.

Similarly, in Studiengesellschaft Kohle the Federal Circuit rejected a request that the court require the second issued patent term be limited to the term of the first. In declining to do so, the Federal Circuit stated that “Congress, in 1952, refused to truncate the term of patents issued [on separate inventions issuing from a single

parent application], although the question was squarely before it." 784 F.2d at 357 (citing In re Bauman). The Federal Circuit also observed that "we are without authority to set our own arbitrary limit" to the length of a patent issuing from a continuation. Id. at 356.

As the CCPA observed, "a limit[ation] on continuing applications is a matter of policy for Congress, not for us." See In re Hogan, 559 F.2d 595, 604 (C.C.P.A. 1977). The rights granted are defined by the statute, not by the discretion of the PTO or the courts:

A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right.

Id. (quoting U.S. v. American Bell Telephone Co., 167 U.S. 224, 247 (1897)).¹⁵

Moreover, the CCPA has explained its reluctance to impose a limitation on the continuation process defined in Section 120, in part, because it would amount to a retroactive rule change" that could divest patentees of "valuable rights to which . . . they were entitled." In re Henriksen, 399 F.2d 253, 262 (C.C.P.A. 1968). MPEP §804 may not incorporate a limitation which Section 120 explicitly rejects.

5. Appellants Are In Full Compliance With Section 120 Of The Patent Act.

Appellants have fully complied with the requirements of Section 120. These facts are undisputed. Moreover, under the law, the issuance of the applicants' other applications as patents presumes that this has occurred.

¹⁵ In another case, the CCPA observed, that "it is unfortunate that a patent should be granted on an application depending on another application filed over 20 years ago . . . but the cure for this deplorable state of affairs rests with Congress, not with us." In re Henriksen, 399 F.2d 253, 262 (C.C.P.A. 1968). Thus, "it is our view, as the judiciary, that it is for the Congress to decide, with the usual opportunity for public hearing and debate, whether such a restriction . . . is to be imposed." Id.

First, the present application was filed before a patent issued from the preceding application. The present application identified the same co-inventors of the inventions. The present application contains a specific reference to the parent application. Finally, the present application complies with the disclosure requirements of Section 112, first paragraph. Therefore, compliance with Section 120 is complete.

The Office Action's statements as to whether applicants could have presented their claims earlier are simply nothing more than the discredited "late claiming" doctrine which has no basis in law.

In summary, the PTO has improperly interpreted Schneller to stand for a proposition for which it does not. The general notion of the existence of a non-statutory non-obvious double patenting has not been located in any learned publication or existing case law. The PTO's reliance upon Schneller to establish the new non-statutory non-obvious category of double patenting is an improper reading of case law. The rule promulgated by the PTO is, therefore, not related to the purposes of the enabling legislation -- it is a plain violation of it. Appellants remind the tribunal that in the event of a disagreement between the MPEP (and its application) and existing case law, the Board of Appeals has an obligation to follow the case law. Ex parte Hartman, 186 U.S.P.Q. 366, 367 (Pat. & Trademark Off. Bd. App. 1974). The PTO Commissioner has clearly acted *ultra vires* to his statutory authority granted under 35 U.S.C. § 6(a). This act is not in accordance with law and, therefore, must be reviewed as an *ultra vires* action under 5 U.S.C. § 706(2)(A).

**D. ASSUMING, ARGUENDO, THAT SCHNELLER CREATES A
THIRD CATEGORY OF DOUBLE PATENTING, IT IS VERY
NARROW DOCTRINE NOT APPLICABLE TO THIS
APPLICATION.**

1. The Factual Background Of Schneller.

Schneller disclosed an invention relating to a wire clip with two features (X and Y) that could be used separately or in combination. In re Schneller, 397 F.2d at 354. Three elements (A, B, and C) of the invention were known in the prior art. Id. The best mode of Schneller's invention was to use the two features in combination (A, B, C, X, and Y). Id. The patent claimed for a wire clip comprising elements A, B, C, and X. Id. A divisional application claiming a wire clip comprising ABCY and ABCXY was voluntarily filed by Schneller. Id. The court found no reason why Schneller voluntarily sought this division method of claiming his invention in separate applications, instead of claiming it in the application in which he first disclosed it. The court then went on to state that "[this] is not a case of an improvement or modification invented after filing. . . Hence it is not the usual 'obviousness-type' double patenting case. Neither is it a 'same-invention-type' double patenting case" In re Schneller, 397 F.2d at 353-54. "[Even] a minimal concern for the public interest requires an Appellant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent." Id. at 354. "The fact is that since . . . they are 'comprising-type' claims, they 'cover' both versions of the clip disclosed in the patent and in the present application because they read squarely thereon." Id. The court stated that the dispositive issue included whether the patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the

appealed claims. Id. at 355. On this basis, the Schneller court affirmed the double patenting rejection. Id.

2. The Office Action Fails To Explicitly Meet The Narrowly Defined Requirements For Double Patenting Under MPEP § 804 (II)(B)(2).

The Office Action fails to provide a proper and complete claim analysis to demonstrate double patenting under the standard articulated in MPEP § 804 (II)(B)(2). The Office Action fails to demonstrate how the specific elements of any specific claim of any existing Harvey patent reads on the specific elements of a specific claim of the present Harvey application. In Schneller, the court specifically cited both the elements in the claims in the patent and the elements in the claims in the Schneller application. The court then demonstrated how the claims in the patent read on the claims in the application to support the double patenting rejection. The Office Action fails to provide such an analysis.

The Office Action attempts to support the rejection by referring to “parts” of Appellants’ total disclosed system or process as opposed to specific elements in specific claims. The Office Action states that since these vaguely identified “parts” are parts of the overall system, claims to one part cover the other parts under MPEP § 804 (II)(B)(2). Office Action, at page 7. The Office Action contains no specific detailed claim comparisons. It merely states that the patented claims recite limitations interrelated with similar features of the application claims and both these claimed features describe the preferred embodiment. This fails to meet the PTO’s burden of proving double patenting under section 804 (II)(B)(2) of the 6th edition of the MPEP.

The Office Action employs the language and words of the claims as prior art against the Appellants. This is improper in a double patenting analysis. As the Federal Circuit recently acknowledged: “it is important to bear in mind that

comparison can be made only with what invention is claimed in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim defines and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference." General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1280-81; 23 U.S.P.Q.2d 1839, 1845-46 (Fed. Cir. 1992). Specifically, words in the claims "are looked to solely for the purpose of determining what has already been patented. They are not treated as prior art [because] they are no more 'prior art' under the statute than the specification." In re Sutherland, Jr., 347 F.2d 1009; 52 C.C.P.A. 1683, 146 U.S.P.Q. 485 (C.C.P.A. 1965). Additionally, it remains impermissible to use the patent disclosure as prior art to support a double patenting rejection. In re Kaplan, 789 F.2d 1574, 1580; 229 U.S.P.Q. 678 (Fed. Cir. 1986); In re Vogel 422 F.2d at 441. Further, the interrelationship of claims is not a basis of rejection for double patenting. Interrelationship of claims among different patents of the same inventor remains a frequent occurrence, as noted by one court: "The exigencies of prosecution commonly compel the issuance of interrelated applications with overlapping disclosures at widely divergent times." In re Saret, 327 F.2d 1005, 1011; 51 C.C.P.A. 1180, 1189; 140 U.S.P.Q. 474 (C.C.P.A. 1964). The Office Action fails to demonstrate where the specific elements of any specific claim of an existing Harvey patent reads on the specific elements of a specific claim of the Harvey application.

Appellants submit that the Office Action misapplies the facts and holding in Schneller to the application and existing patents. The MPEP is relying on ambiguous statements in Schneller. The court in Schneller based its decision on the transitional term "comprising" used in the patent claims. In patent law, the word "comprises" has been construed to mean "including the following elements but not excluding others." Moleculon Research Corp. v. CBS, Inc., 229 U.S.P.Q. 805, 812 (Fed. Cir. 1986). The patent in Schneller contained claims to a wire clip comprising

elements A, B, C, and X. The court in Schneller held that this claim read on the claim in the application of a wire clip comprising elements A, B, C, X, and Y. With respect to the application, the Office Action makes no reference to any specific element of a Harvey patent claim. Rather, the Office Action speaks in generalities with use of the transitional term "comprising."

The Office Action acknowledges that the specific claim limitations in the application have not been claimed in the patents. Office Action, at page 7. The Office Action also states that because the patent claims were directed to parts of Appellants' total disclosure, the recitation of comprising enables those patented claims to cover claim features recited in Appellants' present application claims. Office Action, at page 7. The Office Action asserts that since the headend, intermediate, and subscriber stations are part of the overall system, claims to one part cover the other part under the Schneller decision. Office Action, at page 7. Plainly, this constitutes a misapplication of Schneller.

Schneller does not in any way suggest or imply that a 'part', 'group', 'type', or 'class' of claims that are part of an overall system can be used against each other as prior art for a double patenting rejection *en masse*. Schneller analyzed the elements of the claims of the patent and the application to determine if a double patenting rejection was appropriate. The Office Action misapplies Schneller in the rejection.

3. The Claims In The Present Application Are Distinct From The Claims In The Patents.

The PTO fails to specifically identify all claims from cited Harvey patents that cover specific claims in the present application. Rather, the Office Action references "representative claims" from patents and the present application. Specifically, the Office Action justifies a double patenting rejection by stating generally that "both the patent and present application claims are directed to overlapping and interrelated

areas” Office Action, at page 9. The Office Action does not cite specific elements from claims in a patent covering specific elements in claims in the application. In fact, the Office Action acknowledges that the patent claims and application claims are directed to different elements, stating that this “does not prohibit this rejection if there is common or interrelated subject matter recited.” Office Action, at page 8. The Office Action then references Schneller in support of this erroneous statement, not supported by Schneller.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action relies on the independent and distinct standard as the main factor in the Schneller court’s determination to affirm the double patenting rejection in that case. Office Action, at page 4. The Office Action, however, also states that “[it] is not persuasive for applicants to show that the application claims are patentably distinct from the patented claims.” Office Action, at page 12. The Office Action has misinterpreted this phrase. This phrase means independent ‘or’ distinct. MPEP (6th ed.) § 802.01. The MPEP defines independent as meaning “that there is no disclosed relationship between the two or more subjects disclosed”, i.e. they are not connected. Id. The MPEP defines the term “distinct” as meaning that “two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed” Id. Analyzing the PTO’s cited representative claims referenced in the Office Action, the claims of the present application are clearly distinct from the claims in the issued Harvey patents. Therefore, the claims in the present application are patentable.

**a. First Representative Claims, U.S. Patent 4,694,490,
Claim 9 Covering Present Application, Claim 20.**

In justifying a rejection for double patenting, the Office Action states that “[patent] claims, such as 9, directed to a computer controlled overlay system cover an intermediate station that generates or transmits the embedded signal that controls the computer so that it can generate the overlay signal [such as present application claim 20]. The Office Action then asserts that Applicants’ total disclosure includes the systems of claim 9 and 20, and therefore, “claim 9 ‘covers’ claim 20.” Office Action, at 9. This conclusion is simply not correct.

Patent 4,694,490, claim 9 claims a signal processor means whereby an instruct-to-overlay signal embedded in a video signal, when found under specific conditions, enables the display of a user specific overlay on the video at a television receiver. Present application claim 20 claims an intermediate television transmission station apparatus which receives and stores units of television programming and identification signals which identify programming units or sources and communicates these programming units to a subscriber according to a schedule which tells the output time or channel to communicate the specific unit. These two inventions are distinct. The present application’s claim 20 neither explicitly, nor implicitly, address the concepts of “instruct-to-overlay”, “embedded signal”, “overlay signal”, or “user specific”. Patent claim 9 is concerned with the display at a television receiver of a user specific overlay which differs from other user specific overlays displayed, either simultaneously or asynchronously, at other receiver stations. Application claim 20 does not address this concept at all, but instead is concerned about communicating television programming from a transmission station to a subscriber based on a schedule. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are patentably distinct. The actual claims are shown following.

U.S. Patent 4,694,490, claim 9

Television signal processor means, comprising carrier transmission receiving means,
means for demodulating the output of said receiving means to detect a video program signal,
means normally coupling said video signal to a television receiver,
decoder means for determining the presence or absence of an embedded instruct-to-overlay signal in said video signal at a time when the corresponding overlay is not being displayed,
computer means for generating and transmitting video overlay signals, said overlay signals causing the display of user specific information related to said program material, and
means connected to said computer means and responsive to said decoder means when the presence of said embedded signal is detected for coupling said overlay signals to said television receiver,
the overlays displayed at a multiplicity of said receiver stations being different, with each display specific to a specific user.

Present application, claim 20

An apparatus located at an intermediate television transmission station for controlling the communication of units of television programming to a plurality of subscribers, said apparatus comprising:
a receiver for receiving units of television programming and signals from a remote programming source, each of said received signals identifying one unit of the received units of programming or identifying the programming source of the received unit;
a television programming storage device for storing television programming units and for outputting or playing television programming units stored thereon, said storage device storing signals identifying the units of programming stored thereon;
a switch having respective inputs electrically connected to said receiver and said storage device, said switch having one or more outputs electrically connected to one or more output channels;
a computer electrically connected to said receiver, said switch and said storage device, said computer receiving or having access to a programming schedule, the programming schedule designating for at least one unit of said received units or said stored units of programming at least one of:
(a) a time to communicate the unit of programming to a subscriber; and
(b) an output channel to be used for communicating the unit of programming to a subscriber; and
said computer selecting each said

unit of programming designated by said programming schedule from units received by said receiver and units stored in said storage device based upon said received signals and said stored signals, and said computer configuring said switch and controlling said storage device to communicate said selected units of television programming to a subscriber according to said programming schedule.

b. Second Representative Claims, U.S. Patent 4,704,725, Claim 3 Covering Present Application, Claim 5.

The Office Action justifies a double patenting rejection here, by stating that "[patent] claim 3 appears to be broad enough to include features of the intermediate station, and as such would cover the intermediate station limitations of [present] application claim 5. Applicants' total disclosure includes the methods of claim 3 and 5, and, therefore, claim 3 'covers' claim 5." Office Action, at 10. The Office Action is reading limitations into the patent claims that do not exist. Unclaimed limitations being disclosed does not justify these limitations being used as prior art against claims in the present application. Again, the Office Action's conclusions are unsupported by analysis of the claims themselves.

Patent 4,704,725, claim 3 claims a method of communicating output signals comprising data and user specific signals at a multiplicity of receiver stations from computers to output devices. At least some of the computers can modify the user specific signals by processing modification control signals. The computers communicate the data and user specific signals in response to a received and detected instruct-to-transmit signal. The present application claim 5 claims a method of controlling an intermediate television transmission station which transmits television programming to a subscriber. Television programming,

identification signals related to the television programming, and a program schedule designating time and output channel for communication of the television programming are received. The television programming is stored. The television programming is communicated to a subscriber according to the program schedule. These two inventions are distinct. First, patent claim 3 relates to communication by computers of user specific, dynamically modifiable signals. Present application claim 5 relates to the communication of television programming and nothing suggests any capacity to process or output user specific information to any subscriber. Second, patent claim 3 relates to communicating data upon receipt of an instruct-to-transmit the communication. Application claim 5 communicates the television programming based on a program schedule which could be received far in advance of the actual communicating of the television programming. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are patentably distinct.

U.S. Patent 4,704,725, claim 3	Present application, claim 5
<p>A method of communicating data to a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific signals to one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify the user specific signals transmitted to their associated output devices, each of said computers being programmed to accommodate a special user application, comprising the steps of:</p> <p>transmitting an instruct-to-transmit signal to said computers at a time when the corresponding user specific information is not being transmitted to an output device;</p> <p>detecting the presence of said</p>	<p>A method of controlling at an intermediate television transmission station the communication of television programming from a programming source to a subscriber, said station having a computer for controlling the storage and communication of television programming, said method comprising the steps of:</p> <p>receiving units of television programming from a remote television programming source;</p> <p>receiving signals from said remote television programming source, each of said signals identifying one of said received units of programming or the source of one of said units of programming;</p> <p>inputting said signals to the computer;</p>

instruct-to-transmit signal at selected receiver stations and coupling said instruct-to-transmit signal to the computers associated with said selected stations, and

causing said last named computers to generate and transmit their user specific signals to their associated output devices in response to said instruct-to-transmit signal, thereby to transmit to the selected output devices an output signal comprising said data and said related user specific signals, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

storing at least one of said units of television programming received by said station from said remote programming source;

receiving at the computer a programming schedule, said programming schedule designating for at least one of said units of programming at least one of:

(a) an output channel to be used in communicating the unit of television programming to a subscriber; and

(b) a time the unit of television programming is to be communicated to a subscriber; and

communicating at least one unit of said received units or said stored units of television programming from said transmission station to at least one subscriber according to the programming schedule.

c. Third Representative Claims, U.S. Patent 4,965,825, Claim 24 Covering Present Application, Claim 5.

The Office Action states that "[claim] 24 like claim 3 in 4,704,725, recites broad computer control limitations. This would cover applicants' intermediate station, as represented by claim 5, either because claim 24 is broad enough to read on the intermediate station or because claim 24, even if directed to the subscriber station, would be processing the information generated or transmitted by the intermediate station." Office Action, at 10-11.

Patent 4,965,825, claim 24 claims a method of generating user specific output information at a multiplicity of receiver stations. Each receiver station is programmed with a special user application and has a computer adapted to generate user specific output information. Each receiver station has an output device to which its computer transmits a user specific signal. At a time when the user specific

output information does not exist, an instruct-to-generate signal is transmitted to the receiver stations. In response to the instruct-to-generate signal, the computers generate and transmit to the output devices the user specific output information in user specific signals which are "different, with each output signals specific to a specific user." Application claim 5 relates to an intermediate television transmission station which communicates television programming to a subscriber according to a schedule. In application claim 5, the television programming is received from a remote television programming source. The program schedule is inputted to a computer which controls storage and communication of the television programming. No signal is transmitted at a time when information does not exist. Application claim 5 is not concerned with the concepts of "instruct-to-generate signal" and "user specific information". Patent claim 24 is not so broad it covers present claim 5. The two inventions are patentably distinct and are capable of separate manufacture, use, and sale as claimed.

U.S. Patent 4,965,825, claim 24	Present application, claim 5
<p>In a method of generating computer output at a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific output information content and user specific signals to one or more associated output devices, with at least one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify said computers' method of processing data and generating output information content, each of said computers, being programmed to accommodate a special user application, the steps of:</p> <p>transmitting an instruct-to-generate signal to said computers at a time when</p>	<p>A method of controlling at an intermediate television transmission station the communication of television programming from a programming source to a subscriber, said station having a computer for controlling the storage and communication of television programming, said method comprising the steps of:</p> <p>receiving units of television programming from a remote television programming source;</p> <p>receiving signals from said remote television programming source, each of said signals identifying one of said received units of programming or the source of one of said units of programming;</p> <p>inputting said signals to the computer;</p>

corresponding user specific output information content does not exist, and causing said last named computers to generate their user specific output information content in response to said instruct-to-generate signal, thereby to transmit to each of their associated output devices an output information content and the user specific signal of its associated computer, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

storing at least one of said units of television programming received by said station from said remote programming source;

receiving at the computer a programming schedule, said programming schedule designating for at least one of said units of programming at least one of:

(a) an output channel to be used in communicating the unit of television programming to a subscriber; and

(b) a time the unit of television programming is to be communicated to a subscriber; and communicating at least one unit of said received units or said stored units of television programming from said transmission station to at least one subscriber according to the programming schedule.

d. Fourth Representative Claims, U.S. Patent 5,109,414, Claim 15 Covering Present Application, Claim 20.

The Office Action states "[patent] claim 15 appears to be broad enough to include features of the intermediate station, and as such would cover the intermediate station limitations of application claim 20. Applicants' total disclosure includes the methods of claim 15 and 20, and, therefore, claim 15 'covers' claim 20." Office Action at 11. Again, this conclusion is not supported by the claim language.

Patent 5,109,414, claim 15 claims a signal processing system which receives data from a data source and outputs the data to a matrix switch and a detector, control signals are detected within the received data and stored for further processing, and a processor controls the directing functions of (1) the matrix switch which receives the data as input and can direct selected portions of the data to a data transmission means and (2) the device which stores and transfers the control signals

to the processor. Present application claim 20 claims an apparatus with a storage device for storing units of television programming and signals which identify the stored units, a receiver for receiving from a remote programming source units of television programming and identification signals, a switch which inputs from (1) the storage device and (2) the receiver and outputs to one or more intermediate television transmission station output channels, and a computer which selects at least one unit of programming to communicate to a subscriber based on the identification signals and controls the switch and the storage device to communicate according to a programming schedule. Patent claim 15 relates to controlling a matrix switch to communicate data from a single data source to a data transmission means selectively by processing control signals which are detected within the data and stored for further processing. Application claim 20 relates to communicating at least one unit of television programming from alternate programming sources, one of which is a storage device, to a subscriber via an intermediate television transmission station output channel in accordance with a programming schedule and based on identification signals, some of which are stored at the storage device. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are patentably distinct.

U.S. Patent 5,109,414, claim 15	Present application, claim 20
<p>In a signal processing system, a receiver/distribution means for receiving data from a data source and for outputting said data to a matrix switch means and a control signal detector means, a matrix switch means for receiving said data from said receiver/distributor means and for directing selected portions of said received data to a data transmission means,</p>	<p>An apparatus located at an intermediate television transmission station for controlling the communication of units of television programming to a plurality of subscribers, said apparatus comprising: a receiver for receiving units of television programming and signals from a remote programming source, each of said received signals identifying one unit of the received units of programming or identifying the</p>

a control signal detector means for detecting control signals respecting said data and transferring said control signals to a storage/transfer means, said control signal means being configured to detect said control signals at a predetermined location within said data,

a storage/transfer means for receiving and storing said control signals and for transferring at least a portion of said control signals to a processor means for further processing, and

a processor means for controlling the directing functions of said matrix switch means and the transfer functions of said storage/transfer means based on instructions contained in said control signals.

programming source of the received unit;

a television programming storage device for storing television programming units and for outputting or playing television programming units stored thereon, said storage device storing signals identifying the units of programming stored thereon;

a switch having respective inputs electrically connected to said receiver and said storage device, said switch having one or more outputs electrically connected to one or more output channels;

a computer electrically connected to said receiver, said switch and said storage device, said computer receiving or having access to a programming schedule, the programming schedule designating for at least one unit of said received units or said stored units of programming at least one of:

(a) a time to communicate the unit of programming to a subscriber; and

(b) an output channel to be used for communicating the unit of programming to a subscriber; and

said computer selecting each said unit of programming designated by said programming schedule from units received by said receiver and units stored in said storage device based upon said received signals and said stored signals, and said computer configuring said switch and controlling said storage device to communicate said selected units of television programming to a subscriber according to said programming schedule.

E. CONCLUSION

MPEP § 804 (II)(B)(2) promotes uncertainty to the applicant, the practitioner, and the Examiner because of its lack of identifiable standards. The provision is contrary to established law. Statutory double patenting standards are clear.

“Obviousness”, in this context, is a well developed concept capable of objective standards. This alleged third type offers nothing except subjectivity and the attendant opportunity for abuse. This uncertainty can do nothing but increase appeals taken from examiners’ actions.

The applied MPEP Section 804 (II)(B)(2), defining non-statutory non-obvious double patenting, remains predicated on an improper reading of case law. The PTO’s present rejection based on MPEP Section 804 (II)(B)(2) is no more than an application of the now discredited late claiming doctrine. Even assuming arguendo that the non-statutory non-obvious double patenting rejection is a proper reading of case law, this type of rejection does not apply to the factual situation of the present application.

Appellants believe that the present appeal brief is in full compliance with 1173 O.G. 62 and fully complies with all formal requirements of 37 CFR § 1.192. With respect to the foregoing arguments, Appellants respectfully request that the Board reverse all final Office Action’s rejections and allow the claims to issue.

Dated: September 13, 1996

HOWREY & SIMON

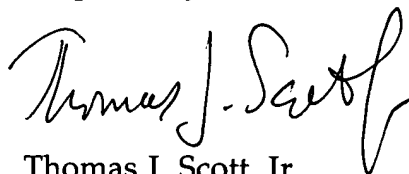
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas J. Scott, Jr.", with a stylized, cursive script.

Thomas J. Scott, Jr.

Registration No. 27,836

APPENDIX A
(37 CFR § 1.192(c)(7))

2. The method of claim 58 wherein said step of storing comprises the steps of:

selecting a specific storage location;
inputting said unit of programming to said selected storage location;
and
storing said inputted unit of programming at said selected location.

3. The method of claim 58 wherein said station comprises a plurality of storage devices, said step of storing at least one of said units of programming comprises the steps of:

selecting a specific storage device;
inputting said unit of programming to said selected storage device; and
storing said inputted unit of programming in said selected storage device.

5. A method of controlling at an intermediate television transmission station the communication of television programming from a programming source to a subscriber, said station having a computer for controlling the storage and communication of television programming, said method comprising the steps of:

receiving units of television programming from a remote television programming source;

receiving signals from said remote television programming source, each of said signals identifying one of said received units of programming or the source of one of said units of programming;
inputting said signals to the computer;

storing at least one of said units of television programming received by said station from said remote programming source;

receiving at the computer a programming schedule, said programming schedule designating for at least one of said units of programming at least one of:

(a) an output channel to be used in communicating the unit of television programming to a subscriber; and

(b) a time the unit of television programming is to be communicated to a subscriber; and

communicating at least one unit of said received units or said stored units of television programming from said transmission station to at least one subscriber according to the programming schedule.

7. The method of claim 5 wherein said station comprises a plurality of receivers for receiving the units of television programming and

the signals from said programming sources, said step of inputting comprising the steps of:

- selecting a specific one of said receivers; and
- inputting said signals received by said selected receiver to said computer.

8. The method of claim 5 wherein said units of programming communicated from said transmission station to said at least one subscriber are selected from:

- (a) the units of programming received at said transmission station from the remote programming source; and

- (b) the units of television programming stored at a local programming source, said local programming source comprising a television programming storage device located at said station for storing units of programming.

9. The method of claim 5 and further comprising the step of logging said step of communicating.

10. A method of controlling at an intermediate transmission station the communication of television programming from a television programming source to a subscriber, said transmission station comprising a computer for controlling the communication of programming, said method comprising the steps of:

- receiving television programming units from a remote television programming source;

- loading a plurality of prerecorded units of television programming onto a local programming source located at said transmission station;

- receiving a plurality of signals from a remote programming source, each said signal designating one unit of said loaded units or said received units of television programming to be communicated to a subscriber;

- identifying in response to each said control signal the unit of programming designated by said signal from:

- (a) the units of programming received at said transmission station from the remote programming source; and

- (b) the units of programming loaded onto the local programming source, said local programming source comprising a programming storage device located at said television transmission station;

- communicating each said identified unit of television programming to the subscriber.

11. The method of claim 10 further comprising a step of receiving a programming schedule, said programming schedule designating at least one of a time and an output channel for communicating each said identified programming unit to a subscriber, wherein said step of communicating comprises the step of communicating each said identified unit of programming to the subscriber according to the programming schedule.

13. The method of claim 10, wherein said step of communicating comprises the step of communicating each identified unit of programming to the subscriber according to one of said plurality of signals, said one signal further designating at least one of a time and a channel for communicating said identified unit to the subscriber.

16. The method of claim 10 further comprising the step of storing one of said units of television programming received by said station in the storage device.

17. The method of claim 11, wherein said step of identifying comprises the steps of:

comparing one of said signals to data in said programming schedule, said data identifying the unit of television programming;

determining based on said programming schedule whether the unit designated by said one control signal will be received from the remote programming source and should be communicated immediately upon receipt to a subscriber, or whether the designated unit is loaded onto the local programming source and should be output therefrom to a subscriber, each of said units of programming loaded onto the local programming source being stored at a storage location on the local programming source; and

identifying the storage location of the unit of television programming designated by said one control signal if the unit designated by said one control signal is loaded onto the local programming source.

18. The method of claim 10 wherein there are a plurality of different types of said signals, and only some of said signals designate said units of programming.

19. The method of claim 10 and further comprising the step of logging said step of communicating .

20. An apparatus located at an intermediate television transmission station for controlling the communication of units of television programming to a plurality of subscribers, said apparatus comprising:

a receiver for receiving units of television programming and signals from a remote programming source, each of said received signals identifying one unit of the received units of programming or identifying the programming source of the received unit;

a television programming storage device for storing television programming units and for outputting or playing television programming units stored thereon, said storage device storing signals identifying the units of programming stored thereon;

a switch having respective inputs electrically connected to said receiver and said storage device, said switch having one or more outputs electrically connected to one or more output channels;

a computer electrically connected to said receiver, said switch and said storage device, said computer receiving or having access to a programming schedule, the programming schedule designating for at least one unit of said received units or said stored units of programming at least one of:

(a) a time to communicate the unit of programming to a subscriber; and

(b) an output channel to be used for communicating the unit of programming to a subscriber; and

said computer selecting each said unit of programming designated by said programming schedule from units received by said receiver and units stored in said storage device based upon said received signals and said stored signals, and said computer configuring said switch and controlling said storage device to communicate said selected units of television programming to a subscriber according to said programming schedule.

22. The apparatus of claim 20, wherein said storage device comprises a plurality of television programming storage devices connected to said switch, said computer further configuring said switch to select a specific storage device.

23. The apparatus of claim 20, said received signals further include information designating one of said received units of programming for storage or delayed communication to a subscriber, wherein said computer further operates to control said switch and said programming storage device to store said units of programming received at said switch that are designated by said received signals for storage or delayed communication to a subscriber.

31. A method of controlling at an intermediate television transmission station the communication of television programming to a subscriber, said station having a computer for controlling the communication of television programming, said method comprising the steps of:

receiving at least one unit of television programming from a remote programming source;

receiving a signal;

storing a plurality of units of programming on a local programming source;

receiving a programming schedule designating for at least one unit of said received units or said stored units at least one of:

(a) an output channel to be used in communicating the unit of programming;

(b) an approximate time the unit of programming is to be communicated to a subscriber;

detecting said signal;

passing said detected signal to the computer;
identifying that said detected signal is a predetermined signal; and
communicating one unit of said at least one received unit or said
stored units of television programming from said transmission station to at
least one subscriber in response to said step of identifying and according to
said programming schedule.

32. The method of claim 31, wherein said signal is one of a plurality
of different signals, said step of identifying comprises the step of identifying
an instruct-to-delay signal, and said method further comprises the steps of
selecting one of said received units and storing said selected unit of
programming in response to said step of identifying the instruct-to-delay
signal, thereby allowing a delayed communication of the selected unit of
programming.

33. The method of claim 32 wherein the selected unit is identified by
said instruct-to-delay signal.

34. The method of claim 32 wherein said selected unit is identified
by being transmitted with said instruct-to-delay signal from the at least one
remote programming source.

35. The method of claim 31, wherein said signal is one of a plurality
of signals, said step of identifying comprises the step of identifying an
instruct-to-communicate signal, said step of communicating being performed
in response to said step of identifying said instruct-to-communicate signal,
said step of communicating comprises the steps of:

selecting a unit of programming from one of:

(a) the units of programming stored on the local programming
source; and

(b) the at least one unit of programming received at said
transmission station from the remote programming source; and

communicating said selected unit to a subscriber at a time and on an
output channel according to said schedule.

36. The method of claim 31, wherein said signal is one of a plurality
of different signals, said step of identifying comprises the step of identifying
an instruct-to-determine-input signal, and said step of communicating
comprises the steps of:

selecting a unit of programming from one of:

(a) the units of programming stored on the local programming
source, said local programming source being electrically connected to a first
input of a switch; and

(b) the at least one unit of programming received at said
transmission station from the remote programming source, said received

units being electrically connected to a second input of the switch, the switch electrically connecting one of the switch inputs to a switch output;

identifying in response to said instruct-to-determine-input signal one of the switch inputs from which to communicate said selected unit of programming to a subscriber;

configuring the switch to transfer the selected unit from the identified switch input to the switch output;

communicating said selected unit from the switch output to a subscriber according to said programming schedule.

37. The method of claim 31, wherein said signal is one of a plurality of different signals, said step of identifying comprises the step of identifying an instruct-to-determine-output signal, and said step of communicating comprises the steps of:

selecting a unit of programming from one of:

(a) the units of programming stored on the local programming source; and

(b) the at least one unit of programming received at said transmission station from the remote programming source;

identifying in response to said instruct-to-determine-output signal an output channel over which to communicate said selected unit of programming to a subscriber; and

communicating said selected unit to a subscriber over the identified output channel.

38. The method of claim 31, wherein said signal is one of a plurality of different signals, the transmission station comprising a switch electrically connecting one of a plurality of switch inputs to one of a plurality of switch outputs, each of said switch outputs electrically connected to one of a plurality of the output channels, the stored units and received units electrically connected to first and second said switch inputs respectively, said step of identifying comprises the step of identifying an instruct-to-transfer signal, and said step of communicating comprises the steps of:

selecting a unit of programming from the stored units or the at least one received unit;

identifying one of the switch inputs from which to communicate the selected unit of programming;

identifying one of the switch outputs to which to transfer said selected unit of programming, said switch output being identified through the designation of the output channel by the programming schedule;

communicating a switch control signal to the switch in response to said steps of identifying the switch input and the switch output;

configuring said switch in response to said switch control signal to transfer said selected unit of programming from said identified switch input to said identified switch output;

communicating the transferred unit of programming according to said programming schedule over a cable television distribution system.

39. The method of either of claims 32, 35, or 37 wherein said step of communicating further comprises the steps of:

- communicating a switch control signal to a switch;
- configuring said switch in response to said switch control signal to transfer one unit of said received units or said stored units of television programming from a selected input of said switch to a selected output of said switch.

40. A method of controlling at an intermediate television transmission station the communication of units of television programming to a subscriber, said station having a computer for controlling the communication of programming, said method comprising the steps of:

- receiving units of television programming from at least one remote television programming source;

- receiving a control signal from said at least one remote programming source and inputting said control signal together with information designating at least one of:

- (a) one of said units of programming;

- (b) a programming source; and

- (c) a transmission channel;

- selecting one of said units in response to receiving said control signal and receiving said inputted information;

- identifying an output channel in response to receiving said control signal and said inputted information;

- receiving a programming schedule designating for each of a plurality of said units of television programming at least one of:

- (a) an output channel to be used in communicating the unit of television programming; and

- (b) a time said unit of television programming is to be communicated to a subscriber; and

- communicating the selected unit of television programming from said transmission station to at least one subscriber according to the programming schedule.

42. The method of claim 40 wherein said station has a plurality of output channels for communicating television programming to a subscriber, said step of communicating further comprising the steps of:

- communicating switch control signals to a switch;

- configuring said switch to communicate said selected unit of television programming to the identified output channel.

44. The method of claim 40 and further comprising the step of logging said step of communicating.

49. The method of claim 8, 17, 38, or 42 further comprising the step of identifying a specific unit of television programming on the basis of a unit identification signal embedded in said unit of television programming.

50. The method of claim 8, 17, 31, 38 or 42 further comprising the step of logging for each unit of television programming communicated to a subscriber a unit identification signal identifying the unit and at least one of:
(a) a specific time when the unit is communicated to a subscriber; and
(b) a specific output channel over which the unit of programming is communicated to a subscriber.

51. The method of claim 5, 11, 31 or 40 wherein said step of receiving a programming schedule comprises the steps of receiving the programming schedule from a remote information source and storing the programming schedule.

52. The method of claim 8, 17, or 42 further comprising the step of receiving said programming schedule from a remote information source.

53. The method of claim 31, wherein said step of storing comprises the steps of:
loading a plurality of prerecorded units of programming onto the local programming source; and
storing a plurality of said received units of programming on the local programming source.

54. The method of claim 31, wherein said signal is one of a plurality of different signals, said step of identifying comprises the step of identifying an instruct-to-overlay signal, said step of communicating being performed in response to identifying the instruct-to-overlay signal, said step of communicating comprises the steps of:

selecting a remote unit of programming from the at least one unit of programming received at said transmission station from the remote programming source;

selecting a local unit of programming from the units of programming stored on the local programming source at the transmission station;

communicating to a subscriber said selected remote unit of programming and said selected local unit of programming to allow the combined presentation at the subscriber of the selected remote unit and the selected local unit.

55. The method of claim 31 wherein said step of receiving comprises the step of receiving a programming transmission via satellite from a television network, said programming transmission comprising at least one

unit of television programming and one or more digital signals embedded in the programming transmission.

56. A method of controlling at a television transmission station the communication of programming from at least one programming source to a subscriber, the station including a computer for controlling the communication of programming, said method comprising the steps of:

receiving at least one unit of television programming at the programming transmission station from a remote television programming source;

loading or inputting at least one prerecorded unit of television programming onto a local programming source;

receiving at the computer a programming schedule that designates, for at least one unit of said prerecorded programming or said received programming, at least one of:

(a) an output channel to be used in communicating the unit of television programming; and

(b) a time the unit of television programming is to be communicated to a subscriber;

selecting, based on said programming schedule, one of said units of programming for communication from:

(a) said at least one unit of television programming received by said station from the remote programming source; and

(b) said at least one prerecorded unit of television programming loaded onto the local programming source;

communicating said selected unit of television programming from said transmission station to at least one subscriber according to said programming schedule; and

logging said step of communicating the selected programming unit.

57. The method of claim 56 wherein said step of receiving comprises the steps of receiving a programming schedule from a remote information source and storing the programming schedule in the computer, the programming schedule designating for at least one unit of said programming received from the remote programming source or at least one unit of said prerecorded programming loaded on the local programming source:

(a) an output channel to be used in communicating the unit of television programming; and

(b) the time the unit of television programming is to be communicated to a subscriber.

58. The method of claim 56 wherein said step of loading or inputting comprises the step of loading a tape onto a video tape player/recorder, said tape player/recorder located at the transmission station, said tape having units of television programming prerecorded thereon.

59. The method of claim 56 wherein said step of receiving comprises the step of receiving a plurality of units of television programming via satellite from a television network.

60. The method of claim 56, further comprising the step of storing at least one of said units of programming received from said remote programming source on a video tape player/recorder at said station for delayed communication to a subscriber.

61. The method of claim 56, wherein said step of communicating further comprises communicating a unit identification signal with the selected unit, said unit identification signal identifying the selected unit of programming, wherein said step of logging comprises the steps of:
detecting the identification signal during said step of communicating;
and
creating a record evidencing said step of communicating the selected programming unit to the subscriber based on said step of detecting.

62. A method of controlling at a television transmission station the communication of television programming from a plurality of programming sources to a subscriber, said station having a computer for controlling the communication of programming, said method comprising the steps of:

receiving a plurality of units of television programming from a remote television programming source;

storing at least one of said units of programming received from said remote programming source at said transmission station;

receiving a programming schedule that designates for at least one unit of said received units or said stored units at least one of:

(a) an output channel to be used in communicating the unit of television programming; and

(b) a time the unit of television programming is to be communicated to a subscriber;

selecting one of said units of programming for communication from:

(a) said units of television programming being received by said station from the remote programming source but which are not stored at said transmission station; and

(b) said at least one of said units of television programming that were received from the remote programming source and stored at said transmission station;

communicating said selected unit of television programming from said transmission station to at least one subscriber according to said programming schedule; and

logging said step of communicating.

63. A method of controlling at a television transmission station the communication of television programming from a plurality of programming

sources to a subscriber, said station having a computer for controlling the communication of programming, said station having a switch for electrically connecting one of a plurality of switch inputs to a switch output, said method comprising the steps of:

- receiving at a receiver located at the station a unit of television programming from a remote television programming source, the receiver connected to a first input of the switch;

- storing a plurality of units of programming on a local programming source, the local programming source connected to a second input of the switch;

- receiving at the computer a programming schedule that designates for at least one unit of said received unit or said stored units at least one of:

- (a) a time the unit is to be communicated to a subscriber; and

- (b) an output channel to be used in communicating the unit to the subscriber;

- selecting, based on said programming schedule, one unit of said received unit or said stored units;

- identifying the switch input connected to the selected unit;

- communicating a switch control signal from the computer to the switch;

- configuring the switch in response to the switch control signal to transfer the selected unit of programming from the identified switch input to the switch output;

- communicating the selected unit from the switch output to a subscriber over an output channel according to the programming schedule; and

- logging said step of communicating.

64. The method of claim 63 wherein said step of storing comprises the steps of:

- storing said received unit on the local programming source; and

- loading a plurality of prerecorded units of programming onto the local programming source.

65. A method of controlling at a television transmission station the communication of units of television programming to a subscriber, the station having a computer for controlling the communication of units of programming, said station comprising a switch that selectably connects one of a plurality of switch inputs to a switch output, said method comprising the steps of:

- storing a plurality of units of programming onto one of a plurality of programming sources, each said programming source electrically connected to one of said switch inputs;

- receiving a plurality of signals from a remote programming source;

- receiving at the computer a programming schedule that designates for at least one of said units of programming at least one of:

(a) an output channel to be used in communicating the unit of television programming; and

(b) a time the unit of television programming is to be communicated to a subscriber;

passing said received signals to the computer;

selecting one of said units in response to receiving one of said signals;

identifying the switch input connected to the programming source

storing the selected unit;

configuring the switch to transfer the selected unit from the identified switch input to the switch output;

communicating the selected unit from the switch output to the subscriber according to the programming schedule; and

logging the step of communicating.

66. The method of claim 65 wherein said step of storing comprises the step of loading a plurality of prerecorded units of television programming onto the programming sources.

67. The method of claim 65 wherein said step of storing comprises the steps of:

receiving a plurality of units of programming from a television network; and

storing said received units of programming on the programming sources.

68. A method of controlling the communication of units of television programming to a subscriber comprising the steps of:

receiving a plurality of units of television programming from a remote programming source;

storing a plurality of units of programming on a local programming source;

receiving a plurality of signals from said remote programming source;

receiving at a computer a programming schedule that designates for one or more units of said stored units or said received units at least one of:

(a) an output channel to be used in communicating the unit of television programming; and

(b) a time the unit of television programming is to be communicated to a subscriber;

selecting one unit of said stored units or said received units based upon at least one of said received signals; and

communicating said selected unit of programming to the subscriber at the time or on the channel designated by said programming schedule.

69. The method of claim 68 further comprising a step of logging the step of communicating said selected unit to the subscriber.

70. The method of claim 68 wherein said step of storing comprises the steps of:

- loading a plurality of prerecorded units of television programming onto the local programming source; and
- storing said received units of programming on the local programming source.

71. The method of claim 68 wherein said step of receiving a plurality of signals comprises the step of receiving a plurality of signals from the remote programming source, each said signal identifying either one unit of said stored units or said received units or a source of one unit of said stored units or said received units.

72. A method of controlling at a transmission station the communication of units of television programming to a subscriber, the transmission station having a computer for controlling the communication of programming, said method comprising the steps of:

- receiving a plurality of units of programming from a remote programming source;
- receiving a plurality of signals from a remote programming source;
- selecting one of said units in response to receiving one of said signals;
- determining, based on said one signal, whether said selected unit should be retransmitted to a subscriber immediately or whether said selected unit should be stored on a local programming source for delayed communication to a subscriber;

- storing said selected unit on the local programming source if, based upon said step of determining, said selected unit should be stored for delayed communication;

- receiving a programming schedule that designates for some of said units of programming at least one of:

- (a) an output channel to be used in communicating the unit of television programming; and

- (b) a time the unit of television programming is to be communicated to a subscriber;

- communicating, at the time or on the output channel designated by said programming schedule, said selected unit from the local programming source to the subscriber if the selected unit is stored on the local programming source for delayed communication;

- logging the step of communicating said outputted unit to the subscriber.

73. The method of claim 72 further comprising the step of communicating said selected unit to the subscriber if, based on said step of determining, the selected unit should be retransmitted immediately.

74. The method of claim 72 wherein said step of communicating comprises the steps of:
outputting, at a time or on a channel designated by said schedule, said selected unit from the local programming source if the selected unit is stored on the local programming source; and
transmitting the outputted unit to the subscriber via a cable distribution system.

75. A method of controlling at a television programming transmission station the communication of units of programming to a subscriber, the station having a computer for controlling the communication of programming, said method comprising the steps of:
storing a unit of programming and a unit identification signal on a local programming source, said unit identification signal identifying said unit of programming;
receiving at the computer a programming schedule that designates for said unit of programming at least one of:
(a) an output channel to be used in communicating the unit of television programming; and
(b) a time the unit of television programming is to be communicated to a subscriber;
outputting said unit of programming and said unit identification signal from the local programming source at the time or onto the output channel designated by said programming schedule;
communicating at least said outputted unit to the subscriber;
detecting the unit identification signal outputted from the local programming source; and
logging said step of communicating based upon said step of detecting.

76. The method of claim 75 wherein said step of logging comprises the step of creating a record evidencing said step of communicating said unit.

77. The method of claim 75 wherein said step of communicating comprises the step of communicating said outputted unit and said outputted unit identification signal to the subscriber.

78. A method of controlling at a television transmission station the communication of television programming from at least one programming source to a subscriber, the station having a computer for controlling the communication of programming, the station comprising a switch for connecting one of a plurality of switch inputs to a switch output, said method comprising the steps of:
receiving a unit of programming from a remote programming source;
receiving at a receiver a signal from the remote programming source, the receiver electrically connected to a first input of the switch;

storing a plurality of units of programming onto a local programming source located at said transmission station, said local source electrically connected to a second switch input of the switch;
scheduling for communication one of said stored units;
selecting, based on the received signal, at least one unit of said received unit or said scheduled unit stored in the local programming source;
identifying the switch input connected to the selected unit;
communicating a switch control signal from the computer to the switch;
configuring the switch in response to said switch control signal to transfer the selected unit from the identified switch input to the switch output;
communicating said selected unit of television programming from said switch output to the subscriber.

79. A method of controlling the communication of television programming to a subscriber, said method comprising the steps of:
receiving a unit of programming from a remote programming source;
receiving at a receiver a signal from the remote programming source, said receiver electrically connected to a first input to a switch;
storing a unit of programming on a local programming source, said local programming source electrically connected to a second input of the switch, the switch electrically connecting one of the switch inputs to at least one switch output;
receiving a programming schedule designating for at least one unit of said received unit or said stored unit at least one of:
(a) an output channel to be used in communicating the unit of programming;
(b) a time the unit of scheduled programming is to be communicated to a subscriber;
detecting said received signal;
identifying that said detected signal is a predetermined signal; and
selecting one unit of said received unit or said stored unit of television programming in response to said step of identifying;
identifying the switch input connected to the selected unit;
configuring the switch to transfer the selected unit from the identified switch input to the at least one switch output;
communicating the selected unit from the at least one switch output to a subscriber, said selected unit being communicated with a unit identification signal and according to said programming schedule, said unit identification signal identifying the selected unit; and
logging said step of communicating, said step of logging comprises the steps of:
(a) detecting the unit identification signal during said step of communicating; and

(b) creating a record evidencing said step of communicating based on said step of detecting the unit identification signal.

80. The method of claim 78 or 79 wherein said step of storing comprises the steps of:
storing said received unit on the local programming source; and
loading a plurality of prerecorded units of programming onto the local programming source.

81. The method of claim 62, 63, 65, 68, 72, 75, 78 or 79 wherein said step of receiving a programming schedule comprises the steps of:
receiving the programming schedule from a remote information source; and
storing the received programming schedule.

82. The method of claim 5, 10, 31, 40, 56, 62, 63, 65, 68, 72, 75, 78, or 79 wherein said step of receiving programming from a remote programming source comprises the step of receiving at least one of:
(a) television programming, including at least one of television video and television audio; and
(b) data.

83. An apparatus for controlling the communication of units of television programming to a plurality of subscribers, said apparatus comprising:
a receiver for receiving units of television programming and signals from a remote programming source;
a television programming storage device for storing television programming units and for outputting or playing television programming units stored thereon, said storage device storing signals identifying the units of programming stored thereon;
a switch having respective inputs electrically connected to said receiver and said storage device, said switch having one or more outputs electrically connected to one or more output channels;
a computer electrically connected to said receiver, said switch and said storage device, said computer receiving or having access to a programming schedule, the programming schedule designating for at least one unit of said received units or said stored units of programming at least one of:
(a) a time to communicate the unit of programming to a subscriber; and
(b) an output channel to be used for communicating the unit of programming to a subscriber; and
said computer programmed to perform the following steps:
(a) selecting each said unit of programming designated by said programming schedule from units received by said receiver and units stored in said storage device;

(b) configuring said switch and controlling said storage device to communicate said selected units of television programming to a subscriber according to said programming schedule.

84. An apparatus for controlling the communication of units of television programming to a plurality of subscribers, said apparatus comprising:

a plurality of storage devices, each said storage device storing at least one unit of television programming and selectively outputting or playing television programming units stored thereon, said storage device storing unit identification signals identifying the units of programming stored thereon;

a switch having respective inputs connected to said storage devices, said switch having one or more outputs electrically connected to one or more output channels;

a computer electrically connected to said switch and said storage devices, said computer receiving or having access to a programming schedule, the programming schedule designating for at least one unit of said stored units of programming at least one of:

(a) a time to communicate the unit of programming to a subscriber; and

(b) an output channel to be used for communicating the unit of programming to a subscriber;

a signal detector connected to the computer for detecting the unit identification signals communicated with said units of programming; and

said computer programmed to perform the following steps for each unit designated in the programming schedule:

(a) identifying one of said storage devices storing the unit of programming;

(b) configuring said switch and controlling said storage device to output the unit of television programming with its unit identification signal;

(c) communicating the outputted unit of programming to a subscriber according to the programming schedule; and

(d) logging the communication of each said unit of programming based on information or data provided by the signal detector.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of :
John C. HARVEY and James W. CUDDIHY : Group Art Unit: 2602
Serial No.: 08/113,329 : Examiner: J. Groody
Filed: August 30, 1993 : File No.: 5634/008
For **SIGNAL PROCESSING APPARATUS AND METHODS**

TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed herewith is:

[X] Appellant's Brief pursuant to 37 C.F.R. § 1.192, *filed in triplicate*.

A check in the amount of 290.00 to cover the filing fee. Please charge any additional fees required in connection with this communication to the deposit account of Howrey & Simon, deposit account number 08-3038. A duplicate of this sheet is enclosed.

Respectfully submitted,

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